

Remarks

This Application has been carefully reviewed in light of the Office Action dated November 10, 2003. To advance prosecution of the Application, Applicants have amended Claims 1-3 and 25-27. These amendments are not considered necessary for patentability. Applicants respectfully request reconsideration and allowance of all pending claims.

Applicants' Claims Comply with 35 U.S.C. § 112, First Paragraph

The Examiner rejects Claims 1-14 and 16-47 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement, stating that the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains or with which it is most nearly connected to make and/or use the invention. Applicants respectfully disagree.

At the outset, Applicants note that there is no requirement that the specification provide concrete examples or illustrations of claimed steps. In fact, "[c]ompliance with the enablement requirement of 35 U.S.C. 112, first paragraph, does not turn on whether an example is disclosed." M.P.E.P. § 2164.02. All that is required is that the "information contained in the disclosure of an application must be sufficient to inform those skilled in the relevant art how to both make and use the claimed invention. *Detailed procedures for making and using the invention may not be necessary if the description is sufficient to permit those skilled in the art to make and use the invention.*" M.P.E.P. § 2164. Applicants respectfully submit that the Specification provides sufficient information and detail to enable those skilled in the art at the time of invention to make and use the claimed invention. Applicants address certain of the Examiner's particular objections below.

For example, the Examiner objects that Applicants describe the enterprise model 24, planning engine model 26, and presentation interface 28 as representing software components, but that "the software components are neither stated nor described in the specification." (Office Action, Page 3) In particular, the Examiner states the "the specification fails to provide any details of a flowchart, program or subroutines to arrive at the various exemplary figures of the drawing. The specification merely provides

conclusionary statements of what the invention may do or will do, but no specific details enabling one of ordinary skill in the art to make and use the invention are provided." (Office Action, Page 3) Applicants respectfully submit that the portions of the Specification to which the Examiner refers are described in sufficient detail to enable those of ordinary skill in the art to make and use the claimed invention.

"The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with the information known in the art without undue experimentation." M.P.E.P. § 2164.01 citing *United States v. Teletronics, Inc.*, 857 F.2d 778, 785 (Fed. Cir. 1988). At least for certain embodiments of Applicants' invention, those having ordinary skill in the art at the time of invention include one or more persons having knowledge related to computer programming and to accounting or another suitable financial discipline.¹ The M.P.E.P. recites, "As a general rule, where software constitutes part of a best mode of carrying out an invention, description of such a best mode is satisfied by a disclosure of the functions of the software. This is because, normally, writing code for such software is within the skill of the art, not requiring undue experimentation, once its functions have been disclosed [F]low charts or source code listings are not a requirement for adequately disclosing the functions of software." M.P.E.P. § 2106.01 citing *Fonar Corp. v. General Electric Co.*, 107 F.3d 1543 (Fed. Cir. 1997).

The Specification recites the functions of the software components to which the Examiner refers, namely enterprise model 24, planning engine model 26, and presentation interface 28. For example, the functions of enterprise model 24 are adequately described at least at Page 5, line 21 through Page 6, line 30 and at Page 7, lines 9-23. As another example, the functions of planning engine 26 are adequately described at least at Page 6, line

¹ Applicants note that "[w]here different arts are involved in the invention, the specification is enabling if it enables persons skilled in each art to carry out the aspect of the invention applicable to their specialty." M.P.E.P. § 2164.05(b) citing *In re Naquin*, 398 F.2d 863, 866 (CCPA 1968); see also *Ex parte Zechnall*, 194 U.S.P.Q. 461 (Bd. App. 1973) (stating that "appellants' disclosure must be held sufficient if it would enable a person skilled in the electronic computer art, in cooperation with a person skilled in the fuel injection art, to make and use appellants' invention."). "In regard to the "skill in the art" standard, in cases involving both the art of computer programming, and another technology, the examiner must recognize that the knowledge of persons skilled in both technologies is the appropriate criteria for determining sufficiency." M.P.E.P. § 2106.02.

8 through Page 7, line 8 and at Page 7, lines 14-23. As another example, the functions of presentation interface 28 are adequately described at least at Page 7, lines 9-23. The disclosure of these functions is certainly sufficient to enable those having ordinary skill in the art at the time of invention to make and use the invention without undue experimentation. Flow charts and source code would not be necessary to do so and, in any event, are not required according to the M.P.E.P. and applicable Federal Circuit case law.

As another example, the Examiner objects that an "accrual method" for calculating expenses is not explained in the Specification. (Office Action, Page 3) Applicants respectfully submit that those of ordinary skill in the art at the time of invention would readily understand the meaning of "the accrual method" for calculating expenses as a method that does not recognize costs until a sale occurs. Furthermore, the same sentence in the Specification in which "the accrual method" is mentioned states, "This method of calculating expenses [the method plainly stated in the previous sentence] more accurately reflects the time value of money than an accrual method *that does not recognize costs until a sale occurs.*" (Page 5, Line 30 through Page 6, Line 2)

As another example, the Examiner objects there is no detail as to the application of certain variables recited at Page 6, lines 2-4 to generate Figures 2-8. (Office Action, Page 3) Applicants respectfully submit that the Specification discusses these concepts in sufficient detail to enable those of ordinary skill in the art at the time of invention to make and use the claimed invention at least at Page 6, line 8 through Page 7, line 23. Additionally, those of ordinary skill in the art at the time of invention would certainly understand the variables raw material costs, operation costs, inventory carrying costs, and handling costs as recited in the Specification at Page 6, lines 2-4.

As another example, the Examiner objects that the term "optimization criteria" is not described. (Office Action, Page 3) Applicants respectfully direct the Examiner's attention to Page 6, lines 15-17, which state, "The optimization criteria may include minimizing inventory, maximizing profit, maximizing resource utilization, maximizing profit margins, or any other suitable criteria according to particular needs." The term optimization criteria is

certainly defined in sufficient detail to enable those of ordinary skill in the art to make and use the claimed invention.

As another example, the Examiner objects that various variables to be used in an optimization criteria are indicated on Page 6, lines 8-24. (Office Action, Page 3) According to the Examiner, "[t]he manner in which to use these variables is not explained or detailed in the specification." (Office Action, Page 4) Applicants respectfully submit that the description on at least Page 6, line 13 through Page 7, line 8 is certainly sufficient to enable those of ordinary skill in the art at the time of invention to make and use the invention.

As another example, the Examiner objects to the use of the word "may," stating "the specification is replete with the word 'may' and that 'The optimization criteria may . . . ' and that the 'engine 26 may maximize profit in terms other than net present value' without any showing or explanation of such is done." (Office Action, Page 4) Applicants respectfully submit that there is no restriction, either in the M.P.E.P. or the governing Federal Circuit case law, on the use of the word "may" in the Specification. In fact, it is quite common to describe the invention in terms of various embodiments and to use the word "may" such that the invention is not limited to a particular embodiment. Applicants respectfully submit that those of ordinary skill in the art at the time of invention would certainly be able to make and use the claimed invention as described in the Specification, regardless of the use of the word "may" throughout the description.

As another example, the Examiner objects that the manner in which to make and use the example reports of Figures 2-8 are not detailed in the Specification. (Office Action, Page 4) Applicants respectfully submit that the Specification certainly provides sufficient detail to enable those of ordinary skill in the art to make and use the claimed invention, including the embodiments illustrated in Figures 2-8.

In addition to the description provided in the Specification, Applicants respectfully submit that a person having ordinary skill in the art at the time of invention would readily

understand the limitations recited in Applicants' claims and other terms or concepts described in the Specification.

For at least these reasons, Applicants respectfully submit that Applicants' specification complies with 35 U.S.C. § 112, first paragraph. Thus, Applicants respectfully request reconsideration and allowance of Claims 1-14 and 16-47.

Applicants' Claims are Allowable over *Moolman*

The Examiner rejects Claims 1-13, 25-26, and 28-37 under 35 U.S.C. § 103(a) as being unpatentable over Moolman, et al., "A capital budgeting model based on the project portfolio approach: Avoiding cash flows per project," Engineering Economist, vol.42, n.2, pp.111-135, Winter 1997, Dialog file 15, Accession No. 01407260 ("*Moolman*"). Applicants respectfully disagree.

With respect to independent Claims 1 and 25, although Applicants believe independent Claims 1 and 25 are allowable over *Moolman* without amendment, to advance prosecution, Applicants have amended independent Claims 1 and 25 to incorporate the limitations of dependent Claims 3 and 27, respectively. As discussed below, the Examiner indicates that dependent Claims 3 and 27 would be allowable if rewritten in independent form. (Office Action, Page 7) For at least these reasons, Applicants respectfully request reconsideration and allowance of independent Claims 1 and 25 and their respective dependent claims.

With respect to independent Claim 8, *Moolman*, whether considered alone or in combination with knowledge generally available to those of ordinary skill in the art at the time of invention, fails to disclose, teach, or suggest certain limitations recited in Claim 8. At the outset, Applicants note that *Moolman* is not directed to, and does not disclose, teach, or suggest, a "system operable on at least one computer for displaying planning information associated with a supply chain," as recited in the preamble to Claim 8. *Moolman* does not discuss computer systems or displaying anything, let alone "displaying planning information associated with a supply chain." In addition, *Moolman* fails to even mention a "supply chain"

or "planning information for the supply chain," as recited in Claim 8. Furthermore, *Moolman* fails to disclose, teach, or suggest "a presentation interface operable to generate a first visual display for selected planning information, the first visual display comprising a profit margin report that indicates, for one or more products associated with a specified resource, a profit margin for each time interval the resource is in use," as recited in Claim 8.

Moolman is directed to a capital budgeting model. (Abstract) According to *Moolman*, "better capital budgeting decisions can be made if costs are not allocated to projects or products; that is, if the concept of cash flow per project is avoided when resources are shared among projects." (Page 7) While the portions of *Moolman* to which the Examiner refers mention the terms "profit," "resource," and "product," nowhere does *Moolman* disclose, teach, or suggest "a presentation interface operable to generate a first visual display for selected planning information, the first visual display comprising *a profit margin report that indicates, for one or more products associated with a specified resource, a profit margin for each time interval the resource is in use,*" as recited in Claim 8. In fact, *Moolman* specifically teaches away from representing anything on a per product basis, stating that "the concept of cash flow per project is not used." (Abstract)

Additionally, the Examiner acknowledges that "a planning engine and a presentation interface to generate a first visual display for displaying a profit margin report are not indicated in *Moolman*, et al." (Office Action, Pages 5-6) However, the Examiner argues that "such would have been obvious to one of ordinary skill in the art by having a skilled programmer programming the teachings of *Moolman*, et al. using a computer system or a network of computers in order to facilitate the review and presentation of the profit margin report." (Office Action, Page 6) First, Applicants respectfully disagree that these distinctions would have been obvious and submit that these distinctions alone are sufficient to require the allowance of Claim 8 over *Moolman*. Second, to the extent the Examiner is relying on "common knowledge" or "well known" art to modify *Moolman*, or if Official Notice is being taken, Applicants request that the Examiner provide a reference in support of this position pursuant to M.P.E.P. § 2144.03. If the Examiner is relying on personal knowledge to supply

the required motivation or suggestion to modify, Applicants request that the Examiner provide an affidavit supporting such facts pursuant to M.P.E.P. § 2144.03.

Furthermore, the rejection of Claim 8 is improper because the Examiner has not shown the required teaching, suggestion, or motivation in *Moolman* or in the knowledge generally available to those of ordinary skill in the art at the time of the invention to modify *Moolman*. The rejected claims are allowable for at least this reason.

The M.P.E.P. sets forth the strict legal standard for finding obviousness based on a combination or modification of references. According to the M.P.E.P., "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge [that was] generally available to one of ordinary skill in the art" at the time of the invention. M.P.E.P. 2143.01. The "fact that references can be combined or modified does not render the resultant combination [or modification] obvious unless the prior art also suggests the desirability of the combination" or modification. *Id.* (emphasis in original).

The governing Federal Circuit case law makes this strict legal standard even more clear.² According to the Federal Circuit, "a showing of a suggestion, teaching, or motivation to combine . . . prior art references is an essential component of an obviousness holding." *In re Sang-Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000)). "Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). However, the "range of sources available . . . does not diminish the requirement for actual evidence." *Id.* In *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that proper evidence of a teaching, suggestion, or

² Note M.P.E.P. 2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").

motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted).³ Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed combination is not sufficient to establish obviousness. See *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988).

With regard to the proposed modifications to *Moolman*, *Moolman* does not mention or even suggest displaying its information to a user in any manner, let alone in the manner discussed in Claim 8. Applicants respectfully submit that the Examiner's proposed modifications to *Moolman* appear to be merely an attempt, with the benefit of hindsight, to reconstruct Applicants' claims and is unsupported by the teachings of *Moolman* or the knowledge generally available to those of ordinary skill in the art at the time of invention. The mere fact that one or more advantages may be gained by modifying *Moolman* is not enough according to the M.P.E.P. and applicable case law.

For at least these reasons, Applicants respectfully request reconsideration and allowance of independent Claim 8 and its dependent claims. For reasons similar to those discussed above with reference to independent Claim 8, Applicants respectfully request reconsideration and allowance of independent Claim 32 and its dependent claims.

³ See also *In Re Jones*, 958 F.2d 347, 351 (Fed. Cir. 1992) (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the

All of Applicants' arguments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from *Moolman*. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. The example distinctions discussed by Applicants are sufficient to overcome the obviousness rejection.

Allowable Subject Matter

The Examiner indicates that Claims 3 and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. As discussed above, although Applicants believe independent Claims 1 and 25 are allowable over *Moolman* without amendment, to advance prosecution, Applicants have amended independent Claims 1 and 25 to incorporate the limitations of Claims 3 and 27, respectively.

Additionally, Applicants note with appreciation the Examiner's indication that Claims 14, 16-24, and 38-47 are allowable over the references of record.

herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at" the claimed invention.).

Conclusion

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims.

If the Examiner believes a telephone conference would advance prosecution of this case in any way, the Examiner is invited to contact Christopher W. Kennerly, Attorney for Applicants, at the Examiner's convenience at (214) 953-6812.

Although Applicants believe no fees are due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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